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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,771	10/23/2003	Joel William Olney	461391/0029	6706

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EXAMINER

MAI, HUY KIM

ART UNIT PAPER NUMBER

2873

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/691,771

Applicant(s)

OLNEY, JOEL WILLIAM

Examiner

Huy K. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-11, 21-28 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-11, 21-28 and 32-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Oath/Declaration*

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because of the C-I-P application. See more details in the previous action.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 37 is rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz et al (6,098,205).

The limitations in claim 37 are shown in Schwartz et al's Fig.1, column 6. Schwartz et al discloses an eyewear comprising a frame 12 constructed and adapted to maintain a lens therein; and, a removable sealing member 14 constructed and adapted to be removably attached the frame 12, the sealing member having a gasket covering at least a portion of a rear surface thereof for engaging a wearer's skin proximate the eyes.

4. Claims 21, 32,33,35, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Angermann et al (4,689,838).

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The limitations in claims 21, 33-35,37 are shown in Angermann et al's Fig. 1-6. Angermann et al disclose eyewear 10 comprising a frame 22 having an inner surface, an outer surface and at least one lens mounted therein; and, a removable sealing member 15 having a front surface formed to closely engage the inner surface of said frame 22, a rear surface, and one or more fasteners for removably attaching the removable sealing member to the frame, wherein said sealing member comprises a gasket 16 on at least a portion of said rear surface for engaging a wearer's skin. Regarding claim 32, Angermann et al discloses the removable sealing member 15 includes one or more ventilation openings 18 therein.

***Claim Rejections - 35 USC § 103 .***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3,7-9,11,34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Angermann et al.

Regarding claims 1-3,7,9,11, Angermann et al disclose eyewear 10 comprising a frame 22 having an inner surface, an outer surface and at least one lens mounted therein; and, a removable sealing member 15 having a front surface formed to closely engage the inner surface of said frame 22, a rear surface, and one or more fasteners for removably attaching the removable sealing member to the frame, wherein said sealing member comprises one or more ventilation openings 18 and a foam rubber gasket 16 on at least a portion of said rear surface for engaging a wearer's skin wherein the ventilation openings 18 are covered by a porous foam 21. It appears

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that Angermann et al discloses the foam gasket 16 and the porous foam cover 21 are separate elements instead of a single gasket cover the ventilation opening and engaging the wearer's skin as claimed. It would have been obvious to a person having ordinary skill in this art to integrally form each of foam gasket and the foam cover of the Angermann et al reference as an integral piece, since it has been held to be within the general skill of a worker in the art to make plural parts unitary as a matter of obvious engineering choice. *In re Larson*, 144 USPQ 347 (CCPA); *In re Lockart*, 90 USPQ 214 (CCPA 1951).

Regarding claims 8,34, Angermann et al discloses the claimed invention except for a pair of lenses 5,5' instead of a single lens as claimed. It is commonly known in the art that a single lens or a pair of lenses in an eyewear is a matter of athletic design. Therefore, it would have been obvious to a person having ordinary skill in the art to modify the lenses in the Angermann et al's eyewear by forming a single lens as a common knowledge in the art. Thus the limitations in claims 8,34 are unpatentable over Angermann et al reference under 35 USC 103.

Regarding claim 10, Angermann et al discloses the claimed invention except for the elastic strap instead of a temple bar as claimed. It is commonly known in the art that an elastic strap and temple bars can be substitute one to another for holding the eyewear on the user's head. Therefore, it would have been obvious to a person having ordinary skill in the art to modify the elastic strap in the Angermann et al's eyewear by forming a pair of temple bars for holding the eyewear on the user's head as a common knowledge in the art. Thus the limitations in claim 10 are unpatentable over Angermann et al reference under 35 USC 103.

7. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Angermann et al.

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Angermann et al disclose eyewear 10 comprising a frame 22 shaped to fit a wearer's face, said frame having an inner surface, an outer surface, a pair of orbital openings for surrounding the eyes of a wearer, a nose bridge connecting said pair of orbital openings, a lens mounting surface mounting a lens within each orbital opening, a temple bracket 32, 39 on each side of the frame 22 for attaching a means 14 for supporting the frame on the wearer's head; and a removable sealing member 15 having an orbital opening, a front surface formed to closely engage the inner surface of said frame, a rear surface, attachment means for removably attaching the removable sealing member 15 to the frame 22 , and a gasket covering 16 at least a portion of the rear surface of the removable sealing member for engaging a wearer's skin. However, the removable sealing means 15 has an orbital opening instead of a pair of orbital openings as claimed. It is commonly known in the art that the air space the eyewear and the wearer's eyes can be separated into a pair of opening or jointed together into a common air space for both eyes. It would have been obvious to a person having ordinary skill in this art to modify the Angermann et al's eyewear by separating the air space into two orbital opening as commonly knowledge in the art for providing a separate air space for each eye. Such modification would not change the scope of the Angermann et al's invention as the applicant does.

8. Claims 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angermann et al.

Since one material has properties better than another material, it would have been obvious to a worker having general skill in this art to select a known material on the basis of its suitability for intended used as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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*Response to Arguments*

9. Applicant's arguments filed Sept. 16, 2004 have been fully considered but they are not persuasive. The applicant argues in page 10, second paragraph that "Angerman, similar to Baharad, is direct to protective goggles, and not eyewear such as sunglasses". The applicant argues with the "empty" limitations because there is no such sunglasses appear in the rejected claims. It appears that the applicant, in his arguments, tries to import the feature "sunglasses" from the specification into his claimed invention in traverse the rejection based on the Baharad and Angermann et al references because no such the limitations appear in the rejected claims. However, the rejections to claims over the Baharad reference are withdrawn because of the telephone interview summary (PTO-413) dated 10/9/02 between the attorney Charles Cantine and the SPE. (It is note that the examiner did not agree anything with the attorney in that interview between the attorney and SPE as he argued in page 9, lines 9-11. The SPE noted in PTO-413 that the examiner was unavailable for interview.)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.

A handwritten signature in black ink, appearing to read "Huy Mai". The signature is fluid and cursive, with the first name "Huy" and last name "Mai" clearly distinguishable.

Huy Mai  
Primary Examiner  
Art Unit 2873

HKM/  
October 22, 2004